

REMARKS

A. Request for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the position that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the Declaration of Mr. Kashiwagi, the amendments to the specification and the following remarks.

B. The Invention

The present invention is directed to a silver salt photothermographic dry imaging material, and an image recording method and image forming method using the same.

In one of the novel aspects of the invention, the photothermographic material contains a bisphenol compound of formula (1) as an image tone control agent and has a sensitivity ratio $S_B/S_A \leq 0.2$. The photothermographic material of the invention exhibits superior storage stability and silver image lasting quality, as well as enhanced sensitivity and minimized fogging (page 4, lines 14-20).

C. Status of the Claims

Claims 1-13 are presented in this case for further prosecution. No claim amendments have been made at this time.

D. Specification Amendments

Several paragraphs beginning at pages 9, 18-21, 47 and 85 have been amended to correct minor typographical errors.

E. Rejections under 35 USC § 102(b) and (e)

Claims 1-13 had been rejected as being anticipated by Fukui (US 2002/0102502). Claims 1-4 had been rejected as being anticipated by Kudo (US 6,808,872). Fukui and Kudo had both been cited to teach a photothermographic material having a compound of formula (1) of the invention. The Examiner had taken the position that the material of Fukui inherently satisfies the claimed S_B/S_A ratio. With respect to Kudo, it appears that the Examiner had taken the same position on inherency, although not specifically stated.

1. The Declaration of Mr. Kashiwagi demonstrates that the materials of Fukui and Kudo do not inherently teach the claimed S_B/S_A ratio

Mr. Kashiwagi has performed tests in order to demonstrate that the materials of Fukui and Kudo do not inherently teach the claimed S_B/S_A ratio. The results of these tests are reported in the enclosed Declaration.

Mr. Kashiwagi prepared and evaluated Sample No. 10 in Table 3 at page 38 of Fukui in accordance with the preparation method of Fukui. Sample No. 10 was chosen as a comparative sample since it contains compound 11-3 (equal to compound 2-3 on page 6 of Fukui). Sample No. 10 of Fukui is also the same as compound 1-1 at page 8 of the Application.

Mr. Kashiwagi also prepared and evaluated Sample No. 118 appearing in Table 2 at cols. 67-68 of Kudo in accordance with the preparation method of Kudo. Sample No. 118 was chosen as a comparative example since it contains compound 1a-1 at col. 11 of Kudo. Compound 1a-1 is also identical to compound 1-1 appearing at page 8 of the Application.

Next, Mr. Kashiwagi evaluated Sample No. 10 of Fukui and Sample No. 118 of Kudo to determine the sensitivity ratio S_B/S_A . The evaluation was performed as taught at page 94, line 22 to page 95, line 9 of the Application. Specifically, as recited in claim 1, Sample Nos. 10 and 118 were subjected to heat treatment, exposed and thermally developed to measure S_B , while the same process was repeated without the heat treatment to measure S_A . The sensitivity ratios S_B/S_A for Sample Nos. 10 and 118 are reported in Table 4 of the Declaration.

As shown in Table 4, Sample No. 10 of Fukui and Sample No. 118 of Kudo both had a sensitivity ratio outside the claimed range. It is therefore respectfully submitted that Mr. Kashiwagi has demonstrated that the cited art does not inherently meet the limitations of claim 1.

F. Rejections under 35 USC § 103(a)

Claims 1-4 had been rejected as being unpatentable over Kudo.

Kudo has a US filing date of June 10, 2003 and an issue date of October 26, 2004. The filing date of this Application precedes the issue date of Kudo, thereby rendering Kudo prior art under 102(e).

According to 103(c), subject matter that qualifies as prior art under 102(e) cannot preclude patentability under section 103 where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. Applicants submit that the subject matter of Kudo and the claimed invention were subject to an obligation of assignment to the same entity at the time the present invention was made.

It is therefore deemed that Kudo can no longer be used to maintain an obviousness rejection under section 103.

G. Double Patenting Rejection

Claims 1-4 had been rejected under the doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7 and 16 of Kudo (US 6,808,872). Presumably, the Examiner had taken the position that the sensitivity ratio S_B/S_A of the present invention is inherent in the material of Kudo similar to the anticipation rejections discussed above.

Applicants respectfully submit that the double patenting rejection is improper in light of the Declaration of Mr. Kashiwagi. As brought out in Table 4 of the Declaration and explained above, the material of Kudo does

not inherently meet the claimed sensitivity ratio. It is respectfully submitted that the double patenting rejection be removed.


H. Conclusion

In view of the foregoing and the enclosed, it is respectfully submitted that the application is in condition for allowance and such action is respectfully requested. Should any extensions of time or fees be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit Account # 02-2275.

Respectfully submitted,

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DCL/mr

Encl: Executed Declaration of Mr. Kashiwagi
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